REMARKS / ARGUMENTS

The present application includes pending claims 1-31, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter. Claims 1-7, 10-17 and 20-27 are rejected under 35 U.S.C. § 102(a) as being anticipated by USPP 2004/0039817 ("Lee"). Claims 8-9, 18-19 and 28-31 are rejected as being unpatentable over Lee in view of USP 7,058,040 ("Schmidt").

REJECTION UNDER 35 U.S.C. § 102

I.   Lee Does Not Anticipate Claims 1-7, 10-17 and 20-27

The Applicant now turns to the rejection of claims 1-7, 10-17 and 20-27 under 35 U.S.C. 102(e) as being anticipated by Lee. With regard to the anticipation rejections under 102(e), MPEP 2131 states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the … claim." *See id.* (internal citation omitted).

Without conceding the Lee qualifies as a 35 U.S.C. § 102(e) prior art reference, the Applicant traverses the rejection as follows.

A.   Rejection of Independent Claims 1, 11 and 21

With regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Lee does not disclose or suggest at least the limitation of "allocating a processor compatible with said determined protocol; and processing said communication signal by said allocated processor, " as recited in Applicant's claim 1.

The Office Action states the following:

"Regarding claim 1, Lee discloses a method for providing communication in a multi-band multi-protocol hybrid wired/wireless network, the method comprising:
- determining a protocol (selecting one of 802.11 family protocols, see 110-114 fig.1 and ¶29) associated with a communication signal for an access point (AP) (signal associated with AP, see ¶29);
- allocating a processor within the access point (**inherently allocating/assigning a processor within the selected AP for communication**, see 138 fig.1 and ¶59); and - processing the communication signal by the allocated processor (process the communication signal by the allocated processor **within the selected AP**, see 138 fig.1 and ¶59).
See the Final Office Action at page 2. The Examiner equates Lee's wireless

station checking and selecting an AP with a matching configuration operating modes (i.e., one of 802.11 family protocols) to Applicant's "determining a protocol …for an access point". However, Lee does not disclose any processor within the AP. Even assuming arguendo, that a processor is required in order for Lee's AP to function, nevertheless, Lee still does not disclose any details on how the processor operates in relation to the determined protocol, let alone disclose "**allocating a processor within the AP …compatible to the determined protocol**," as recited in Applicant's claim 1.

B.   Traversal of Inherency

The Examiner seems to resort to an inherency argument in the Office Action. However, the Examiner's inherency argument is deficient at least based on the following reasons.

The Applicant submits that a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. *See* Manual of Patent Examining Procedure at § 2112. "The fact that a certain result or characteristic **may** occur or be present in the prior art **is not sufficient to establish the inherency** of that result or characteristic." *See id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

> To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.
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> *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir.

1999). The Applicant respectfully submits that neither Lee itself nor the Office Action "make[s] clear that the missing descriptive matter," said to be inherent "is necessarily present in" Lee.

A rejection based on inherency must be based on **factual or technical** reasoning:

>In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Applicant respectfully submits that the Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claims 1, 11, 21, 30 and 40 of the present application stands rejected based on a conclusory statement of inherency, rather than upon a "basis in fact and/or technical reasoning." Accordingly, the Applicant respectfully submits that, absent a "basis in fact and/or technical reasoning" for the rejection of record, that rejection should be reconsidered and withdrawn. Lee does not overcome the above deficiency of "**allocating a processor** within the AP …**compatible to the determined protocol**".

Therefore, based on the foregoing rationale, the Applicant maintains that Lee does not disclose or suggest at least the limitation of "**allocating a processor** within the AP …**compatible to the determined protocol**," as recited in Applicant's independent claim 1, and there is no anticipation by Lee. The Applicant submits that claim 1 is allowable, and respectively requests that the rejection to claim 1 under 35 U.S.C. 102(e) be withdrawn.

Independent claims 11 and 21 are similar in many respects to the independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

C.   Rejection of Dependent Claims 2-7, 10, 12-17, 20, and 22-27

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Lee has been overcome and request that the rejection be withdrawn. Additionally, claims 2-7, 10, 12-17, 20, and 22-27 depend directly or indirectly from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

D.   Rejection of Dependent Claims 2, 12 and 22

The Examiner states the following at page 3 of the Office Action:

> "Regarding claim 2, Lee discloses, "further comprising **selecting the allocated processor from a pool of available processors** for the processing of the communication signal (110-114 fig.1)."

The Applicant points out that the Examiner has incorrectly equated Lee's step 110 in Fig. 1, which discloses **a wireless station** <u>**selects an AP**</u> that matches its 802.11 protocol, to "**selecting the allocated processor** (<u>**within the AP**</u>) **from a pool of available processors**...," as recited in Applicant's claim 2. In addition, Lee does not disclose any processor in an AP. The Examiner's above allegation is simply unsupported by Lee's disclosure. Claim 2 is, therefore, submitted to be allowable. Claims 12 and 22 are rejected under the same rationale as claim 2, are also submitted to be allowable.

E.   Rejection of Dependent Claims 3, 13 and 23

The Examiner states the following at page 3 of the Office Action:

"Regarding claim 3, Lee discloses, "wherein the allocating further comprises **updating the processor** to be capable of the processing of the communication signal (122 fig.1)."

The Applicant points out that the Examiner has incorrectly equated Lee's step 122 in Fig. 1, which discloses **a wireless station <u>selects an AP</u>** based on an active scan for the highest RSSI level of an AP, to "**allocating including updating the processor (<u>within the AP</u>)** ...," as recited in Applicant's claim 3. In this regard, Lee's active scan has nothing to do with the AP updating its processor. Claim 3 is, therefore, submitted to be allowable. Claims 13 and 23 are rejected under the same rationale as claim 3, are also submitted to be allowable.

F.   Rejection of Dependent Claims 4, 14 and 24

The Examiner states the following at page 3 of the Office Action:

"Regarding claim 4, Lee discloses, "wherein the **updating further comprises downloading protocol code** compatible with the determined protocol **to the processor** (inherent to access one of 802.11 protocols, see, ¶29)."

The Applicant points out that the Examiner has incorrectly equated Lee's **wireless station <u>selects an AP</u>** based on its configured 802.11 protocol, to "**updating the processor (<u>within the AP</u>) including downloading protocol code** ...," as recited in Applicant's claim 4. In this regard, Lee's wireless station selecting an AP has nothing to do with the AP downloading protocol code to its processor.

Claim 4 is, therefore, submitted to be allowable. Claims 14 and 24 are rejected under the same rationale as claim 4, are also submitted to be allowable.

G. Rejection of Dependent Claims 5, 15 and 25

The Examiner states the following at page 3 of the Office Action:

"Regarding claim 5, Lee discloses, "further comprising storing the compatible protocol code in a memory (inherent to save the protocol code in a not shown memory, see fig.1 and, ¶29)."

The Applicant points out that the Examiner's inherency argument is deficient without factual support, as already explained above. Furthermore, **Lee discloses that the mobile station itself,** (not the AP), **stores** the **RSSI and QBSS** data of the AP in each channel (See Lee ¶29). In this regard, Lee's wireless station storing the AP's RSSI and QBSS data has nothing to do with the AP storing the downloaded protocol code to its memory. Claim 5 is, therefore, submitted to be allowable. Claims 15 and 25 are rejected under the same rationale as claim 5, are also submitted to be allowable.

H. Rejection of Dependent Claims 6, 16 and 26

The Examiner states the following at page 3 of the Office Action:

"Regarding claim 6, Lee discloses, "wherein the downloading further comprises retrieving the compatible protocol code from a portion of the memory (retrieve to configure, see ¶29)."

The Examiner's is referred to Applicant's above arguments in claim 4, that Lee does not disclose downloading protocol code into the AP processor. Claim 6 is,

therefore, submitted to be allowable. Claims 16 and 26 are rejected under the same

rationale as claim 6, are also submitted to be allowable.

I. Rejection of Dependent Claims 7, 17 and 27

The Examiner states the following at page 4 of the Office Action:

> "Regarding claim 7, Lee discloses, "further comprising associating the
> determined protocol code with the portion of the memory (store
> obtained information, see ¶35)."

The Examiner's is referred to Applicant's above arguments in claim 5, that

Lee does not disclose storing downloaded protocol code into the AP memory. Claim

7 is, therefore, submitted to be allowable. Claims 17 and 27 are rejected under the

same rationale as claim 7, are also submitted to be allowable.

REJECTION UNDER 35 U.S.C. § 103

In order for a prima facie case of obviousness to be established, the Manual of

Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

> The key to supporting any rejection under 35 U.S.C. 103 is the clear
> articulation of the reason(s) why the claimed invention would have been
> obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 82
> USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection
> under 35 U.S.C. 103 should be made explicit. The Federal Circuit has
> stated that "rejections on obviousness cannot be sustained with mere
> conclusory statements; instead, there must be some articulated reasoning
> with some rational underpinning to support the legal conclusion of
> obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

> The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

II. The Proposed Combination of Lee and Schmidt Does Not Render Claims 8-9 and 18-19 and 28-31 Unpatentable

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 102(e) as being anticipated by Lee has been overcome and request that the rejection be withdrawn. Schmidt does not overcome Lee's deficiencies. Additionally, claims 8-9 and 18-19 and 28-31 depend directly or indirectly from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-31.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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